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EXAMINER

HALPERN, MARK

ART UNIT PAPER NUMBER

1731

1A

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/720 550

Applicant(s)

KYTONEN ET AL

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, it is in full compliance with the statutory minimum of thirty (30) days and will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED, 35 U.S.C. § 133.
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.134(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 3/10/2003
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 14-34 is/are pending in the application
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 14-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of
- 1 ☐ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) to a provisional application.
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1 ☐ Notice of References Cited (PTO-892)
- 2 ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3 ☐ Information Disclosure Statement(s) (PTO-449) Paper No(s) \_\_\_\_\_
- 4 ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5 ☐ Notice of Informal Patent Application (PTO-150)
- 6 ☐ Other \_\_\_\_\_

### DETAILED ACTION

- 1) The finality of rejection issued in Office Action of 10/16/2002, Paper No. 8, is withdrawn.
- 2) Acknowledgement is made of Amendment received 3/10/2003, Paper No. 9. Applicants amend claims 14, 27, and cancel claims 35-36.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention

- 3) Claims 14-34, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 14, line 8, and claim 27, line 9, recite "...less than and not equal to 30...". Calender having a nip length of less than and not equal to 30 mm is new matter not supported by the original disclosure. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 14-15, 18-22, 27-28, 31-32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson (WO 96/28609) in view of Van Haag (5,582,689).

Claims 14-15, 27-28: Eriksson discloses a process of making coated paper board, where the board is first calendered, followed by said board being coated by a coating device and then calendered in a heated calender (Eriksson, pg. 5, lines 8-18, Examples, and pg. 11, lines 6-13). Eriksson fails to recite that the calendaring of the at least one coated surface of the base web is performed with a calender having a nip length of less than and not equal to 30 mm. It would have been obvious, to one skilled in the art at the time the invention was made, that the calenders of Eriksson, which have a nip of length from 3 cm to 10 cm, which is 30 mm to 100 mm (Eriksson, pg. 3, lines 24-25) would perform the same way as would the calender of the present invention, since the difference between the Eriksson nip length and the claimed nip length is minimal, and the present invention does not indicate any unusual results obtained from using calenders of slightly shorter nip lengths. Therefore, it is deemed obvious to use the calenders of Eriksson over the calenders of present invention. Eriksson fails to disclose that the calendaring prior to coating to be performed with a shoe calender. Van Haag discloses a shoe calender (Van Haag, Abstract, and Figures 1 and 2). It

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would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Van Haag with Eriksson into the design of Eriksson, because such a combination would provide an additional means of calendering the paper board prior to coating, since Eriksson discloses that pre-calendering may be performed by any type of calender (Eriksson, pg. 5, lines 17-18), and thus produce a more economic product in the design of Eriksson.

Claims 18-20, 31-32; the shoes of Van Haag are divided into sectors in a travel direction where compression load is independently controllable (Abstract, col. 2, line 58 to col. 3, line 40, and Figures 1 and 2)

Claims 21-22; Van Haag does not disclose specific pressures applied, however it would have been obvious, to one skilled in the art at the time the invention was made, that even if no numerical numbers are specified, the reference can meet the zero value of the range claimed. Eriksson discloses pressure of 1,000 kPa (col. 6, line 20).

5) Claims 16-17, 23-26, 29-30, 33-34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson in view of Van Haag, and further in view of Koivukunnas (5,483,873).

Claims 16-17, 29-30, 33-34; Eriksson in view of Van Haag is applied as above for claim 14, Eriksson in view of Van Haag fails to disclose a coated surface of the base web being calendered with a belt calender having a nip formed between two rolls. Koivukunnas discloses a belt calender having a nip between two rolls (col. 5, lines 43-67, and Figure 3). It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Koivukunnas with Eriksson in view

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of Van Haag, because such a combination would provide for improved calendering means and method thus providing support and control of the web in the calendering process of Eriksson.

Claims 23-24; Koivukunnas discloses heating of the web in the calendering operation until the web reaches glass transition temperature (Abstract, col. 6, lines 1-39).

Claims 25-26; Koivukunnas discloses wetting of the web with aid from a heated backing roll (col. 6, lines 1-39).

### ***Response to Amendment***

6) Applicant's arguments filed 3/10/2003, have been fully considered but they are not persuasive.

In argument filed 9/9/2002, Applicants alleged that the new dependent claims 35-36 recited a limitation that Eriksson has not disclosed: a calender of the coated web having a nip length of "less than 30 mm". Examiner responded that Eriksson recites a nip of length of 30 mm to 100 mm., and thus reads on the claimed feature since the lower number of the Eriksson range touches on the upper number of the present range. Examiner should have pointed out that the new dependent claims 35-36 recite new matter not supported by the original disclosure: a calender of the coated web having a nip length of "less than 30 mm", which represents a new upper limit on the calender nip length. Also, even though, Eriksson failed to recite that the calendaring of the at least one coated surface of the base web is performed with a calender having a nip length of

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less than and not equal to 30 mm. it would have been obvious, to one skilled in the art at the time the invention was made, that the calenders of Eriksson, which have a nip of length from 30 mm to 100 mm, would perform the same way as would the calender of the present invention, since the difference between the Eriksson nip length and the claimed nip length is minimal, and the present invention did not indicate any unusual results obtained from using calendars of slightly shorter nip length. The point is moot, however, since claims 35-36, have been cancelled.

### ***Conclusion***

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone no. is 703-308-0651.

Mark Halpern  
Patent Examiner  
Art Unit 1731

March 18, 2003

